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In re Application of
Willem Johannes De Wit
US Application No.: 10/009,110
PCT Application No.: PCT/ZA00/00104
International Filing Date: 06 June 2000
Priority Date: 07 June 1999
Attorney's Docket No.: 01-1749
For: BENEFICIATION OF ZIRCON

JUL 03 2002
Decl. Document - Final
DUE DATE: 8/26/02
BY: K.B./MZ

DECISION ON PAPERS
UNDER 37 CFR 1.42

This is a decision on the national stage application papers submitted 15 April 2002 for entry into the national stage in the United States of America. A review of the Declaration reveals that inventor Willem Johannes De Wit is deceased. Applicant's submission of the Declaration taken together with the indication inventor Willem Johannes De Wit is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 06 June 2000, applicants filed international application PCT/ZA00/00104, which claimed a priority date of 07 June 1999 from application ZA 99/3815. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 13 November 2000. Accordingly, the thirty-month period for meeting the requirements for entry into the national stage expires at midnight on 07 December 2001.

On 07 December 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic filing fee. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau. Applicants did not submit an oath or declaration of the inventors (35 U.S.C. 371(c)(4)).

On 14 February 2002, the United States Designated/Elected Office (USPTO) mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) was required as well as the surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). Applicants were given a TWO (2) MONTH period from

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the mail date of the Notification to properly respond, with extensions of time obtainable under 37 CFR 1.136(a).

On 15 April 2002, applicants timely filed a "TRANSMITTAL LETTER" in response to the Notification of Missing Requirements which included a Declaration executed the Legal Representative of Willem Johannes De Wit and the required surcharge of \$130.00 under 37 CFR 1.492(e).

DISCUSSION

37 CFR 1.42 states:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

37 CFR 1.497(a)-(c) state:

(a) *When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to §§ 1.494 or 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 ter.1, he or she must file an oath or declaration that:*

- (1) *Is executed in accordance with either §§ 1.66 or 1.68;*
- (2) *Identifies the specification to which it is directed;*
- (3) *Identifies each inventor and the country of citizenship of each inventor; and*
- (4) *States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.*

(b) *The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.*

(2) *If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or §1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.*

© *Subject to paragraph (f) of this section, if the oath or declaration meets the*

requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and §§ 1.494© or 1.495(c). However, if the oath or declaration does not also meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 or an application data sheet will be required in accordance with § 1.67.

The declaration does not satisfy the requirements of 37 CFR 1.497(a)(3), (b)(2), and (c).

Regarding 37 CFR 1.497(b)(2), it is noted that a legal representative has signed the Declaration for the deceased inventor, Willem Johannes De Wet. Furthermore, the representative's residence, citizenship, and post office address has also been completed in the Declaration. However, the signature of the representative as well as the printed information of the representative's residence, citizenship, and post office address are not legible. It can not be determined as to who is the legal representative. Accordingly, 37 CFR 1.497(b)(2) has not been properly satisfied. Applicant should provide a new declaration which provides the clearly printed name and signature of the legal representative as well as the representative's residence, citizenship, and post office address.

Further, the declaration does not set forth the required information for the deceased inventor.

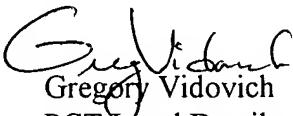
The declaration filed by applicant does not satisfy 37 CFR 1.63(c)(1) and (c)(2).

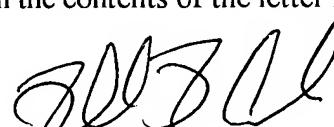
CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**

Applicant is required to submit a declaration in compliance with 37 CFR 1.42 and 1.497 within a time period of TWO (2) MONTHS from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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